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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,614	10/20/2003	Kunio Harada	HIRA.0125	2602
38327	7590	11/15/2007	EXAMINER	
REED SMITH LLP			VATHYAM, SUREKHA	
3110 FAIRVIEW PARK DRIVE, SUITE 1400			ART UNIT	
FALLS CHURCH, VA 22042			PAPER NUMBER	
			1795	
			MAIL DATE	
			DELIVERY MODE	
			11/15/2007	
			PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/687,614	<b>Applicant(s)</b> HARADA ET AL.	
	<b>Examiner</b> Surekha Vathyam	<b>Art Unit</b> 1795	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/944,410.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 31 October 2007 has been entered.

### ***Claim Rejections - 35 USC §§ 102 and 103***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Zare et al. (US 4,675,300).

Regarding claim 1, Zare ('300) discloses an electrophoresis apparatus (see fig. 3) comprising: a plurality of capillaries (column 7, lines 5 – 7); a voltage applier (36) applying voltage between both ends of the capillaries (column 3, lines 44 – 47); a laser light source (46) irradiating a laser (column 3, line 64 – column 4, line 3); and a fluorescent detector detecting a fluorescence emitted from inside of the capillaries

(column 4, lines 5 – 17), wherein each of the plurality of capillaries comprises a first region coated with a polymer, a second region having a surface of the capillary exposed for a predetermined length in the longitudinal direction (column 3, lines 32 – 37 and fig. 4), and a third region defined between the first and second regions and covered with a tapered polymer coating with a thickness that becomes thinner from the first region to the second region (see fig. 4). Figure 4 depicts the slope of the surface of the coating of the third region makes an angle of approximately 30 degrees from the first region to the second region relative to the longitudinal direction of the capillary which would have disclosed or suggested a slope of the surface of the coating of the third region makes an angle of 70 degrees or less from the first region to the second region relative to the longitudinal direction of the capillary to one of ordinary skill in the art.

Regarding claim 2, Zare ('300) discloses the electrophoresis apparatus wherein a material of the tapered polymer coating is polyimide (column 3, lines 34 – 37).

#### ***Terminal Disclaimer***

7. The terminal disclaimer filed on 4 September 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application Number 10/897099 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Response to Arguments***

8. Applicant's arguments filed 31 October 2007 have been fully considered but they are not persuasive. Applicant argues the capillary tubing with tapered coating of the instant application "has the advantage of preventing stresses from concentrating on the glass tube of the capillary tube at the edge of the capillary when the capillary tube is bent after the windows are processed". Applicant's remarks regarding preventing stress do not relate to claim limitations.

9. Examiner cannot consider arguments based on evidence not yet submitted.

10. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

11. As detailed in the rejection of claims 1 and 2 above, Zare ('300) discloses and/or renders obvious all the claimed features especially in fig. 4. In contrast to the situations of *Hockerson-Halberstadt, Inc. v. Avia Group* 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) and *In re Wright* 193 USPQ 332 (CCPA 1977) where it was held that drawings can not be relied upon for disclosing a size unless stated to be to scale, slope is not affected by the scale of the drawing. In other words, while sizes change with the scale of a

drawing, angles do not. Nonetheless, the slope limitation is also anticipated if is an inherent result of the process of making disclosed by the prior art. "[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product" *In re Fitzgerald*, 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best* 195 USPQ 430, 433-434 (CCPA 1977); also reproduced in MPEP 2112(V)).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Surekha Vathyam whose telephone number is 571-272-2682. The examiner can normally be reached on 7:30 AM to 4:00 PM.

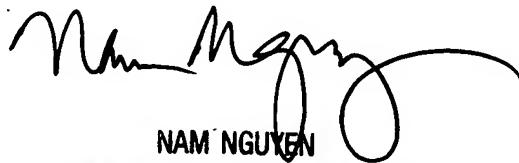
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam X. Nguyen can be reached on 571-272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SV/  
9 November 2007



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